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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/029,225	12/20/2001	Monica A. McClintic	5038US (01-01-058)	3449
4743	7590	02/23/2005	EXAMINER	
MARSHALL, GERSTEIN & BORUN LLP			NGUYEN, KIM T	
6300 SEARS TOWER			ART UNIT	
233 S. WACKER DRIVE			PAPER NUMBER	
CHICAGO, IL 60606			3713	

DATE MAILED: 02/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/029,225

Applicant(s)

MCCLINTIC ET AL.

Examiner

Kim Nguyen

Art Unit

3713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 December 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-24,26-36,38-45,47-52,54-102,104-109 and 111-115 is/are pending in the application.
- 4a) Of the above claim(s) See Continuation Sheet is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3,10-12,16-21,27-36,38,39,47-49,54,55,57-74,81-83,87-96,104-106 and 111-115 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 12/6/04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

Continuation of Disposition of Claims: Claims withdrawn from consideration are 4-9,13-15,22-24,26,40-45,50-52,56,75-80,84-86,97-102 and 107-109.

### **DETAILED ACTION**

Examiner acknowledges receipt of the amendment on 12/6/04 .

According to the amendment, claims 25, 37, 46, 53, 103, and 110 have been canceled, and claims 1-24, 26-36, 38-45, 47-52, 54-102, 104-109 and 111-115 are pending in the application.

#### ***Claim Objections***

1. Claims 38-39 are objected to because of the following informalities:

Claims 38-39 depend on the canceled claim 37.

Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-3, 16-18, 71-74, and 87-89 are rejected under 35 U.S.C. 103(a) as being unpatentable over Luciano, Jr. et al (US 6,050,895).

- a. As per claim 1, Luciano discloses a gaming device comprising a gaming unit 107b (Fig. 1B) in one embodiment for operating a primary game, the

outcome of the primary game initiates a bonus game (col. 8, lines 48-67; col. 9, lines 1-40; col. 5, lines 63-67); and a bonus game controller 107a (Fig. 1B) connected to the gaming unit. Luciano primarily discloses that the primary game is a skill game and the bonus game is a random game (col. 10, lines 38-46). However, in a different embodiment, Luciano suggests that it would have been obvious to design the primary game as a game of chance and the bonus game as an interactive skill game (col. 12, lines 39-51; col. 11, lines 8-26). Further, a game of chance selects outcomes randomly would have been well known. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to design the primary game as a game of chance and the bonus game as a physical interactive skill game in view of Luciano's suggestion in order to randomly allow the player to proceed to another play of game.

b. As per claim 2-3, Luciano discloses providing a sports ball game (col. 5, lines 28-31; col. 12, lines 1-2). Further, including different types of sport game such as baseball game which is well-known to include a strike receiver and striker would have been well known. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to replace the ballgame of Luciano with a well-known baseball game in order to allow the player to play a baseball game.

c. As per claim 16-18, providing a specific random outcome occurring in response to input of a wager, setting a predetermined wager value or a predetermined number of wagers would have been well known.

d. As per claim 71-74 and 87-89, refer to discussion in claims 1-3 and 16-18 above.

4. Claims 10-12, 19-21, 27-36, 38-39, 47-49, 54-55, 57-70, 81-83, 90-96, 104-106, and 111-115 are rejected under 35 U.S.C. 103(a) as being unpatentable over Luciano, Jr. et al (US 6,050,895) in view of Kelly et al (US Patent No. 6,007,426).

a. As per claim 10-11, Kelly discloses a virtual reality interaction game of skill (col. 16, lines 51-55; and col. 7, lines 23-26). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to provide the virtual reality interaction system of Kelly to the gaming device of Luciano in order to provide interaction between the player with a computer generated object.

b. As per claim 12, providing a game in which the player manipulates a computer generated object to strike another computer generated object would have been well known to a person of ordinary skill in the art at the time the invention was made.

- c. As per claim 19-21 and 27-29, refer to discussion in claims 1, 10-12, and 16-18 above.
- d. As per claim 30 and 33, refer to discussion in claims 1 and 10 above. Further, extending the number of gaming units connecting to a bonus game controller would have been both well known and obvious design choice to allow a plurality of players to share the same bonus game.
- e. As per claim 31-32, refer to discussion in claim 1 above. Further, using a random number generator to generate a random outcome would have been well known to a person of ordinary skill in the art at the time the invention was made.
- f. As per claim 34-35, refer to discussion in claims 1 and 16 above.
- g. As per claim 36, Luciano discloses including a specific bonus outcome occurring in the bonus game (col. 12, lines 50-51).
- h. As per claim 38-39 and 47-49, refer to discussion in claims 2-3, and 10-12 above.
- i. As per claim 54-55, locating gaming unit remotely and identifying a player at a gaming machine would have been well known.
- j. As per claim 57, Kelly discloses allowing the players to compete against one another (col. 12, lines 6-17; col. 16, lines 62-64; and col. 21, lines 54-56).
- k. As per claim 58-60, Kelly discloses assigning common game element (same question) to all the players (col. 12, lines 14-16, and col. 16, lines 62-

63). Further, randomly selecting the common game element, assigning individually game element to each player, and allowing exchange of the individually game element would have been well known.

l. As per claim 61-64, Kelly discloses a bonus event computer (col. 15, lines 56-59; and col. 16, lines 31-32). Further, as to claims 63-64, extending the bonus game controller into a plurality of bonus game systems which separate from the gaming units would have been both obvious and design choice.

m. As per claim 65-66, refer to discussion in claims 16-18 above.

n. As per claim 67-70, triggering a bonus game including passing a fixed amount of time, allowing the player to decline participating in a shared bonus game, or skipping a session of play but still returning qualification to participate in the bonus game in a later shared bonus game event would have been well known.

o. As per claim 81-83, 90-96, 104-106, and 111-115, refer to discussion in claims 1-3, 10-12, 16, 30, and 57-60 above.

### ***Response to Arguments***

Claims 36, 38-39 and 47-49 were indicated as allowable subject matter in the office action issued on 7/1/04. The indication of allowable subject matter is withdrawn in view of the newly found reference of Luciano.



5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kim Nguyen whose telephone number is 571-272-4441. The examiner can normally be reached on Monday-Thursday during business hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan Thai, can be reached on 571-272-7147. The central official fax number for the organization where this application or proceeding is assigned is 703-872-9306.

kn  
Date: February 12, 2005



Kim Nguyen  
Primary Examiner  
Art Unit 3713